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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,691	12/07/2000	Jeffrey D. Carnevali	1361040-2002.1	3233

20999 7590 02/29/2012  
FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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BAXTER, GWENDOLYN WRENN

ART UNIT	PAPER NUMBER
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3632

MAIL DATE	DELIVERY MODE
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02/29/2012

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/733,691	CARNEVALI, JEFFREY D.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gwendolyn Baxter	3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) ☒ Claim(s) 43-45,50,51,59,61-63,67-75,82-87 and 91-94 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 43-45,50,51,59,61-63,67-75,82-87 and 91-94 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) ☒ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

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This is in response to the amendment filed November 19, 2009 for serial number 09/733,691, Universally Positionable Mounting Device, filed on December 7, 2000.

Claims 43-45, 50, 51, 59, 61-63, 67-75, 82-87 and 91-94 are pending.

### ***Double Patenting***

The terminal disclosure filed November 19, 2009 has been approved.

### ***Specification***

The disclosure is objected to because of the following informalities: since applicant has filed more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. An example of the modified insertion is provided below.

More than one reissue application has been filed for the reissue Patent No. 9,999,999. The reissue applications are application numbers 09/999,994. (the present application), and 09/999,998, which is a continuation reissue of Patent No. 9,999,999.

Design Application 29/370,076 has been omitted from the amended specification filed October 5, 2007. Column 1, line 6 should read as follows:

Notice: More than one reissue application has been filed for the reissue of U.S. Patent No. 5,845,885. The reissue applications are application numbers 09/733,691

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(the present application), Design Patent Application No. 29/370,076 (which is a continuation of 09/733,691), 10/300,951 (which is a continuation of 09/733,691), and 10/991,325 (which is a divisional of 09/733,691).

Please note: This modified insertion must be totally underlined. See 37 CFR 1.173. 2. A supplemental declaration will be required to address this change. Appropriate correction is required. See MPEP 1451.

### ***Recapture***

Claims 43-45, 50, 51, 59, 61-63, 67-75, 82-87, and 91-94 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the

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application for the patent cannot be recaptured by the filing of the present reissue application.

Applicant has provided reissue claims, which are broader than the patented claims, and omits limitations that were added and argued during the original prosecution of the patent to overcome an art rejection(s). Therefore, such an omission in a reissue claim is impermissible recapture. For instance, the surrendered limitations of patent claim 30, "the bifurcated arm assembly" have been omitted from reissued claims 43, 50, 59, 61, 63 and 70, respectively.

Claims 91 and 94 refers to original patent application claim 40, wherein this claim depends on claim 38. Applicant has provided claims 91 and 94 which is a listing of limitations that are broadened recitations and appear to be very different from that recited in the original patent application claims. These claims are as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claims. The subject matter surrendered is the subject matter of an application which was amended and, on a limitation-by-limitation basis, the territory falling between the scope of the application claim which was amended.

The amendment filed May 19, 1997, the amended original patent claims 38, set forth amended limitations (underlined) which overcame the rejection under 35 U.S.C. Section 102(b), however, fail to preclude a 112 issue set forth therein. The patentee originally claimed the subject matter alleged to infringe but then narrowed the claim in

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response to a rejection, he may not argue that surrendered territory. Additionally, the modifications made in the response filed in March 18, 1998 which have overcome the 112 issues should be considered.

### ***Response to Arguments***

Applicant's arguments filed November 19, 2009 have been fully considered but they are not persuasive. The modified portions appear to be materially different from that of the surrendered limitations and must be corrected.

### ***Remarks***

Claim 43, line 5, "first and second arm sections" should read -a bifurcated arm assembly- and line 10, "arm sections" should read -the bifurcated arm assembly-.

Claim 50, line 6, "respective rigid arm sections" should read -a bifurcated arm assembly- and line 10, "the rigid arm sections" should read -the bifurcated arm assembly-.

Claim 59, line 6, "an arm assembly" should read -a bifurcated arm assembly- and line 11, "the arm assembly" should read -the bifurcated arm assembly-.

Claim 61, line 5, "an arm assembly" should read -a bifurcated arm assembly- and line 9, "the arm assembly" should read -the bifurcated arm assembly-.

Claim 63, line 6, "a split arm assembly" should read -a bifurcated arm assembly- and line 12, "the split arm assembly" should read -the bifurcated arm assembly-.

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Claim 70, line 6, "a plurality of arm sections, at least two of the arm sections" should read –a bifurcated arm assembly of the arm assembly- and line 10, "the arm sections" should read –the bifurcated arm assembly-.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Baxter whose telephone number is (571)272-6814. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrell McKinnon can be reached on 571-272-4797. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Gwendolyn Baxter/

Primary Examiner, Art Unit 3632

February 17, 2012